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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,062	03/28/2001	Mary Smiley	42390P10856	4052

8791 7590 11/30/2005

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EXAMINER

LAYE, JADE O

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/820,062	SMILEY ET AL.	
	Examiner	Art Unit	
	Jade O. Laye	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/22/01 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's amendments and arguments filed 6/10/05 have been entered and fully considered. Applicant's arguments with respect to the application of *Carr* are moot in view of the new ground(s) of rejection.

Applicant argues that the subject matter of the present invention and the *Carr* reference were both subject to a common obligation of assignment at the time of Applicant's invention. In response, the application of *Carr* has been withdrawn.

In an effort to clarify the inventive intent in the claims, Applicant narrowly amended claims 1, 9, 14, 20, and 22 to include receiving enhancement data by a receiver "not configured to process enhancement data." However, Applicant has failed to clarify this distinction because the Examiner is unable to find support and/or an explanation in the Specification for the proposed clarification. Moreover, the plain language of Applicant's Claim 2 contradicts such a distinction. Claim 2 recites limitations that address "receiving the television broadcast" and "extracting said enhancement data from the television broadcast." Therefore, how can Applicant's system "extract" enhancement data" as recited in Claim 2, while at the same time, the system is "not configured to process enhancement data" as recited in Claim 1? "Extracting" data is a form of "processing" data. Therefore, Applicant's amendment has only rendered the claims more confusing and, as will be applied below, the Examiner is applying a rejection under 35 U.S.C. 112.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of *Carrying* out his invention.

2. Claims 1-5, 9-12, 14-18, 20, and 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For an explanation of the Examiner's position, please refer to the response section above.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 6-8, 13, 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by *Reynolds et al.* (US Pat. Pub. No. 2002/0138852).

As to claim 6, *Reynolds et al* disclose a system capable of transcoding media and associated content (i.e., enhancement data) into a format which is compatible with the transport network and delivering said media/associated content to a client. *Reynolds* goes on to teach the

system is capable of analyzing the client side receiver capabilities in order to determine what transmission format should be utilized. (Abstract; Paragraphs [0003-0007, 0013]). This, in essence, forms part of a user profile because each user could have different receiver capabilities. Accordingly, *Reynolds et al* anticipate each and every limitation of Claim 6.

Claim 19 corresponds to the method claim 6. Thus, it is analyzed and rejected as previously discussed.

As to claim 7, *Reynolds* further teaches that pricing information can be associated with various delivery formats and thus, used as a basis for selecting said format. (Paragraphs [0020, 0030, 0041]). Therefore, *Reynolds* anticipates each and every limitation of claim 7.

Claim 8 corresponds to the method claim 7. Thus, it is analyzed and rejected as previously discussed.

As to Claim 13, *Reynolds* further teaches the system transmits Java-type, JavaScript-type, audio/video streams, and HTML formats (i.e., tag based). ([0020 & Table 1]). Moreover, HTML is a markup language used to create web pages (i.e., web page format). Accordingly, *Reynolds et al* anticipate each and every limitation of Claim 13.

Claim 21 corresponds to the method claim 13. Thus, it is analyzed and rejected as previously discussed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
November 16, 2005.



VIVEK SRIVASTAVA
PRIMARY EXAMINER